

REMARKS

Summary of the Office Action

Claims 1-4, 9 and 12 stand rejected under 35 U.S.C. §102(a) as being anticipated by *Shibuya et al.* (U.S. Patent No. 5,963,353).

Claims 1-4, 9 and 12 stand rejected under 35 U.S.C. §102(e) as being anticipated by *Hisamatsu et al.* (U.S. Patent No. 6,188,503).

Summary of the Response to the Office Action

Applicants have amended claims 1, 9 and 12 to more clearly define the invention. Accordingly, claims 1-4, 9 and 12 remain pending.

Applicants submit a verified translation of Japanese Patent Application P. Hei. 11-255592 concurrently herewith.

The Rejections under 35 U.S.C. §102(a)

Claims 1-4, 9 and 12 stand rejected under 35 U.S.C. §102(a) as being anticipated by *Shibuya et al.* The rejections are respectfully traversed for at least the following reasons.

With respect to independent claim 1, as newly-amended, Applicants respectfully submit that *Shibuya et al.* does not teach or suggest the claimed combination, including at least “a mass member detachably fixed to a non-rotary section of a driving motor for rotating a polygon mirror.”

The Examiner suggests that an inner ring 125 of *Shibuya et al.* is a “non-rotary section” and an upper thrust plate 124 of *Shibuya et al.* is a “mass member” as claimed in the present application. The Examiner alleges that *Shibuya et al.* discloses that the upper thrust plate 124 is attached to the inner ring 125. However, as shown in Figures 1 and 5 and further as described in column 1 of *Shibuya et al.*, the upper thrust plate 124 and the inner ring 125 are integrally formed together with a lower thrust plate 123. In contrast, in the present invention, as shown in Figs. 2 and 3, the mass member 72 is shown to be screw-fixed to the stationary shaft 44. In other words, the mass member 72 is detachably fixed to the stationary shaft 44. Therefore, Applicants respectfully submit that *Shibuya et al.* fails to teach or suggest the claimed combination, including at least “a mass member detachably fixed to a non-rotary section of a driving motor for rotating a polygon mirror,” as recited by newly-amended independent claim 1.

With respect to independent claims 9 and 12, for similar reasons set forth above, Applicants respectfully submit that *Suzuki et al.* fails to teach or suggest the claimed combination, including at least that “a mass member is detachably fixed to a non-rotary section of a driving motor for rotating a polygon mirror,” as recited by newly-amended independent claims 9 and 12.

Applicants respectfully assert that the rejections under 35 U.S.C. §102(a) should be withdrawn because *Shibuya et al.* does not teach or suggest each and every feature of independent claims 1, 9 and 12, as newly-amended. As pointed out in MPEP §2131, “[t]o anticipate a claim, the reference must teach every element of the claim.” Thus, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987).” Furthermore, Applicants respectfully

assert that dependent claims 2-4 are allowable at least because of their dependence upon the amended independent claim 1 and the reasons set forth above.

The Rejections under 35 U.S.C. §102(e)

Claims 1-4, 9 and 12 stand rejected under 35 U.S.C. §102(e) as being anticipated by *Hisa*. The rejections are respectfully traversed for at least the following reasons.

Applicants respectfully submit that *Hisa* should not be considered as prior art in the present application under 35 U.S.C. §102. On July 11, 2000, Applicants filed a Claim for Priority and a Certified copy of Japanese Patent Application P. Hei. 11-255592, which was filed in Japan on September 9, 1999. Pursuant to 37 C.F.R. §1.55(a), Applicants submit concurrently herewith a verified translation of Japanese Patent Application P. Hei. 11-255592. The U.S. filing date of *Hisa* is December 6, 2000 which is after the priority date to which this application is entitled. Therefore, Applicants respectfully request withdrawal of the rejections of claims 1-4, 9 and 12 under 35 U.S.C. §102(e).

With no other rejections pending, Applicants respectfully assert that claims 1-4, 9 and 12 are in condition for allowance.



ATTORNEY DOCKET NO.: 046601-5053
Application No.: 09/613,742
Page 6

Conclusion

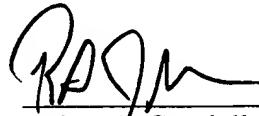
In view of the foregoing, Applicants request the entry of the amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

Attached hereto is a marked-up version of the changes made by the current amendment. The attachment is captioned "Version with markings to show changes made."

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.R.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,
MORGAN, LEWIS & BOCKIUS LLP

By:



Robert J. Goodell, Ph.D.
Registration No. 41,040

Dated: February 4, 2003

CUSTOMER NO. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, NW
Washington, D.C. 20004
Telephone: (202) 739-3000
Facsimile: (202) 739-3001



ATTORNEY DOCKET NO.: 046601-5053
Application No.: 09/613,742
Page 7

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Kindly amend pending independent claims 1, 9 and 12 as follows:

1. (Twice Amended) A rotary deflector comprising a mass member [~~attached~~] **detachably fixed** to a non-rotary section of a driving motor for rotating a ploygon mirror, wherein a periphery of the mass member is larger than that of the non-rotary section of the driving motor.

9. (Twice Amended) An optical scanning unit comprising:

a rotary deflector, wherein a mass member is [~~attached~~] **detachably fixed** to a non-rotary section of a driving motor for rotating a ploygon mirror, a periphery of the mass member is larger than that of the non-rotary section of the driving motor.

12. (Twice Amended) An image forming apparatus comprising:

an optical scanning unit comprising a rotary deflector in which a mass member is [~~attached~~] **detachably fixed** to a non-rotary section of a driving motor for rotating a ploygon mirror, a periphery of the mass member is larger than that of the non-rotary section of the driving motor.